

Appl. No. 09/395,805
Response dated March 15, 2004
Reply to Office Action of Dec. 17, 2003

REMARKS

Applicants respectfully request the Examiner to reconsider and withdraw all objections and rejections and then to issue a Notice of Allowance.

Claims 1 and 4-12 remain pending. They are as presented in the March 6, 2003 Amendment.

Rule 133 Statement

Applicants' representative acknowledges the Examiner's courtesy during various telephone discussions in February 2004. The discussions centered on whether samples prepared as stated in the Nakao Rule 132 Declaration were not basis for an inherency rejection. On February 23, 2004, Applicants' representative furnished the Examiner with a courtesy copy of the March 6, 2003 Amendment and a courtesy copy of the Nakao Rule 132 Declaration. It is understood that the Examiner re-reviewed the March 6, 2003 Amendment as well as the Nakao Rule 132 Declaration before the last of the telephone discussions was conducted on or about February 26, 2004. It was understood that the Examiner would reconsider the rejection and Applicants would re-present their traverse in their Response.

Rejoinder of claims

Applicants respectfully request the Examiner to rejoin claims 11 and 12. It is respectfully submitted that dependent claim 11 should be rejoined with claims 1 and 4-10. Claim 12 can be made the subject of this application since the issues have been developed and the search burden would therefore seem much reduced. *See, e.g.*, MPEP 803.

Traversing the Prior Art Rejection

Claims 1 and 4-10 were rejected on an inherent anticipation theory grounded on U.S. Patent No. 6,025,286 to Kawatsu. In the rejection, it was postulated that Samples 7, 8 and 9 in the Nakao Rule 132 Declaration were "of the reference" (Office Action, page 4).

It will be appreciated for present purposes that practicing an embodiment as described in the *prior art* reference must necessarily, inevitably inherently produce the

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alleged claimed invention. Otherwise, the rejection must be withdrawn. "[I]nherency ... may not be established by probabilities or possibilities." Continental Can Co. USA v. Monsanto Co., 948 F.2d 1264, 1268-69 (Fed. Cir. 1991).

Introduction to Traverse -

Applicants traverse this repeated rejection and respectfully invite attention to Remarks in their March 6, 2003 Amendment starting from page 5 and, for instance, their October 24, 2002 Preliminary Amendment from page 7. It will be appreciated from their October 24, 2002 paper that Samples 7, 8 and 9 are not literal repeats of an Example from the cited Kawatsu reference.

1. Sample 2 vitiates the factual predicate for the rejection.

Arguendo in view of the Examiner's hypothesis, Sample 2 appears to be a useful basis upon which to reconsider the alleged inherency rejection.

Sample 2 in the Nakao Rule 132 Declaration can be understood to be almost the same as the allegedly working Example 2 in the cited Kawatsu reference from the standpoint of such parameters as weight of fiber (11.0 g/m²), film thickness (1.5μm versus 1.2μm) and, for instance, average fiber diameter (3.8μm versus 4.0μm).

However, Sample 2 showed inferior performance, *i.e.* creasing on the drum, in comparison to Applicants' Example 5.

It follows that one would expect like inferior performance from the product (or the process) according to Example 2 in the Kawatsu reference.

2. Comparative Example 1 vitiates the factual predicate for the rejection.

Arguendo in view of the Examiner's hypothesis, Applicants additionally but respectfully submit that Comparative Example 1 would seem to provide useful information upon which to withdraw the alleged inherency rejection.

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Applicants respectfully submit the record establishes that Comparative Example 1 effectively rebutted the now repeated rejection over the Kawatsu reference. Applicants respectfully invite the Examiner's attention to the Remarks in their March 6, 2003 Amendment, from page 6. Applicants again respectfully invite the Examiner's attention to the Remarks in their October 24, 2002 Preliminary Amendment, from page 9.

The Examiner will appreciate that Applicants' Comparative Example 1 and the properties of a product according to the Kawatsu reference seem similar. The Examiner is respectfully invited to re-review Table 1, page 20, in the specification in comparison to Kawatsu at column 3, lines 63-67 (film thickness of 0.1 to 5 μ m); column 4, lines 5-8 (average fiber diameter of 0.5 to 20 μ m); and column 4, lines 14-17 (basis weight of fibers of 1 to 20 g/m², preferably 3 to 14 g/m²).

However, the product that was prepared according to Comparative Example 1 was inferior in performance. It creased on the drum as seen from Table 1, page 21.

It follows that one would expect like inferior performance from the product (or the process) according to Example 2 in the Kawatsu reference.

3. Samples 7, 8 and 9 are not repeats of an Example in the Kawatsu reference.

Applicants respectfully point out that the Samples 7, 8 and 9 themselves are not *per se* prior art. Applicants respectfully point out that Samples 7, 8 and 9 were obtained in a manner similar to that described in the present specification as stated in the Nakao Rule 132 Declaration. The Examiner will therefore appreciate that Samples 7-9 were not prepared literally as a repeat of an Example from the cited Kawatsu reference. Indeed, for instance, it is apparent that the preparation process as in Applicants' Example 1 is not literally the same as in the Kawatsu reference.

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Conclusion

Applicants respectfully, but strenuously, request the Examiner to reconsider and withdraw the prior art rejection of claims 1 and 4-10 under 35 U.S.C. §102(e) over the Kawatsu reference. It is respectfully submitted that an allowance can, and in fairness, include claims 11 and 12 as well.

Applicants respectfully solicit a Notice of Allowance as to all claims 1 and 4-12.

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The signature below certifies this paper was filed by facsimile using PTO facsimile number 703-872-9306 this 15th day of March 2004.

Respectfully submitted,

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